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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

VALENTI, ANDREA M

ART UNIT	PAPER NUMBER
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3643

DATE MAILED: 01/27/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

8

Office Action Summary

Application No.

09/914,793

Applicant(s)

VAN TOL ET AL.

Examiner

Andrea M. Valenti

Art Unit

3643

-- The MAILING DATE of this communication appears on the cover sheet with the corresponding address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 November 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-17 and 21-26 is/are rejected.
- 7) ☒ Claim(s) 18-20 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 1, 3-5, 7-9, 11, 12, 14, and 21-23 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 5,979,110 to Tai.

Regarding Claim 1, Tai teaches a holder with at least one carrier (Fig. 3 #30) and a series of clamping elements (#1) which are fixed to the carrier and which are each adapted to clamp a plant cutting (#21), wherein the clamping elements are fixed to the carrier such that plant cuttings clamped in the clamping elements extend substantially parallel to each other, and the center of each of the clamping elements is situated substantially in the same central plane.

Regarding Claim 3, Tai teaches the carrier extends as a strip (Fig. 3 #30) and that the clamping elements (#1) are fixed to the carrier at regular mutual distances

Regarding Claim 4, Tai discloses that the clamping elements (#1) are each fixed on the same side of the carrier (Fig.3 #30).

Regarding Claim 5, Tai discloses that the mutual distance between the clamping elements on one side of the carrier is greater than or equal to the mutual distance between the center of the clamping elements so that two carriers with their clamping elements **can be** placed between each other (Fig. 3 #30 and #1).

Regarding Claim 7, Tai discloses the carrier is divided into substantially rigid pieces (Fig.3 area above first clamp, area between second clamp, and area below second clamp; Tai Col. 2 line 31), which are couple in mutually flexible manner (Tai Col. 2 line 1-2).

Regarding Claim 8, Tai teaches the carrier has been made substantially from rigid material (Tai Col. 2 line 31).

Regarding Claim 9, Tai teaches the clamping elements have been made from softer material than the carrier (Tai Col. 2 line 1-2).

Regarding Claim 11, Tai teaches the clamping elements (#1) each have at least two parts (#15 and #10), at least one of which is connected resiliently to the carrier (#15).

Regarding Claim 12, Tai discloses that the parts each take substantially the form of a semi-cylindrical surface, wherein both parts are connected to the carrier such that in the non-loaded situation both parts are separated on either side by a narrow gap (Fig. 1-3).

Regarding Claim 14, Tai teaches the inner wall of both parts of the clamping elements together have a substantially oval section (Fig. 2 #101 and 16).

Regarding Claim 21, Tai inherently teaches applicant's broad claim language that each of the parts of the clamping elements are connected to the carrier (Tai Fig. 4) for tilting on an axis extending substantially at a right angle to the plane of the carrier

Regarding Claim 22, Tai teaches each of the parts of the clamping elements are connected to the carrier by means of a connection subject torsion (Fig. 3 #13).

Regarding Claim 23, Tai teaches that the parts of the clamping elements each have a plate which has a clamping surface on one side of the connection to the carrier and are provided on the other side with an engaging surfaces for moving apart the clamping surfaces in the manner of a lever (Fig. 3 #152 and #13).

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-5, 7-9, and 25-26 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 3,026,650 to Miller.

Regarding Claim 1, 3-5, and 7-9, Miller teaches a holder with at least one carrier (Miller #11) and a series of clamping elements (#12 and 20a) which are fixed to the carrier and which are each adapted to clamp a plant cutting (Fig. 3), wherein the clamping elements are fixed to the carrier such that plant cuttings clamped in the clamping elements extend substantially parallel to each other, and the center of each of the clamping elements is situated substantially in the same central plane (Fig.1).

Regarding Claim 2, Miller teaches the central plane extends at a right angle to the plant cuttings (Fig. 1).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 10, 15-17, and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,979,110 to Tai.

Regarding Claims 10 and 24, Tai teaches clamping elements, but is silent on injection molding. However, Tai teaches the clamping elements are plastic (Tai Col. 2 line 1-2) and injection molding is an old and well-known means of plastic forming. It would have been obvious to one of ordinary skill in the art to modify the teachings of Tai for ease of manufacturing.

Regarding Claims 15 and 16, Tai teaches one bridge (Tai #14), but is silent on two bridges for connecting to the carrier. However, it would have been obvious to one of ordinary skill in the art to modify the teachings of Tai since the modification is merely a duplication of parts to provide additional support to the clamp structure and does not present a patentably distinct limitation.

Regarding Claim 17, Tai as modified teaches that both parts of the clamping element are mutually connected by a thin strip of material (#12).

Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,979,110 to Tai in view of U.S. Patent No. 5,052,086 to Nasuno.

Regarding Claim 6, Tai is silent on the carrier being substantially flexible. However, Nasuno teaches a substantially flexible carrier (Nasuno Fig. 5 #4). It would have been obvious to one of ordinary skill in the art to modify the teachings of Tai with the teachings of Nasuno since the carriers are merely alternate equivalents selected to accommodate different plant types and configurations.

Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,979,110 to Tai in view of U.S. Patent No. 5,060,417 to Court.

Regarding Claim 13, Tai is silent on the inner walls of both parts of the clamping (Tai #101) elements have an upward diverging form on one side. However, Court teaches a clamping element plant holder with upward diverging form on the side (Court Fig. 1 #14). It would have been obvious to one of ordinary skill in the art to modify the teachings of Tai with the teachings of Court to provide a form that will support a bud attached to the plant as taught by Court (Court Fig. 6).

Claims 25-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 3,026,650 to Miller.

Regarding Claims 25 and 26, Miller teaches the carrier is manufactured from flat material in which at least three lips (Miller Fig. 3 #12 and 11) at the position of each clamping element (Miller #20a), which lips are adapted to fixedly clamp the plant. Miller

is silent on the holder being manufactured out of paper or plastic and is punch formed. However, it would have been obvious to one of ordinary skill in the art to modify the teachings of Miller since the modification is merely the selection of a known material for intended use in order to reduce manufacturing costs.

Allowable Subject Matter

Claims 18-20 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

Applicant's arguments filed 12 November 2002 have been fully considered but they are not persuasive.

Examiner maintains that Tai teaches all the limitations presented by applicant's broadly worded claim language. Tai in fact teaches a single carrier (Tai Fig. 4 #30) and a series of clamping elements (Tai Fig. 4 #1). Applicant's use of the phrase "extend substantially parallel" is broad because it depends on where one draws the plane through the clamping element. The clamps present by Tai in Fig. 4 are substantially parallel. Depending on the size of the plant stem and the size of the clamp, Tai can inherently hold more than one cutting. Furthermore, merely changing the orientation of the clamps taught by Tai is an obvious modification to one of ordinary skill in the art.

In response to applicant's argument that there is no suggestion to combine the references Nasuno and Court with Tai, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce

the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Nasuno merely teaches an alternate equivalent carrier than the one taught by Tai. Nasuno teaches clamping the plant cutting to the carrier, but in this instance the carrier is flexible. One of ordinary skill in the art would be motivated to modify Tai with a flexible carrier to accommodate different types of plant configurations. Court teaches a plant cutting clamp with upward diverging form on the side provides support for flowering plants. One of ordinary skill in the art would be motivated to modify the clamp of Tai with added support taught by Court to prevent breakage and damage to the plant.

Regarding the teachings presented by Miller, examiner maintains that Miller does present all of the structural limitations claimed by Applicant. For example, applicant does not claim that the bottom of the plant cutting is freely suspended, i.e. that there is nothing surrounding it. A plant cutting could be in a vase, in the ground, or it could be in a plant pot with soil (as the result of a propagation method) in which case the teachings of Miller are applicable and the device could be used for transport. Clamping can be defined as holding something securely or to fasten and element #20a of Miller does in fact clamp the plant cutting.

Therefore, applicant has not presented structural limitations that distinguish applicant's invention over the teachings of the prior art.

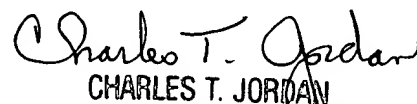
Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andrea M. Valenti whose telephone number is 703-305-3010. The examiner can normally be reached on 7:30am-5pm M-F; Alternating Fridays Off. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter M. Poon can be reached on 703-308-2574. The fax phone numbers for the organization where this application or proceeding is assigned are 703-306-4195 for regular communications and 703-305-0285 for After Final communications. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-4357.

AMV
January 23, 2003


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